

## **REMARKS**

Claims 22-36 are pending in the application, of which Claim 34 has been withdrawn from consideration. Applicant proposes herein an amendment of Claims 22 and 32 to substitute the word "body" for the phrase "wall member". Applicant submits that bases for the amendment can be found throughout the application, claims and drawings as originally filed and as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

## **CLAIM OBJECTIONS**

Claim 22 stands objected to for a certain informality. Applicant has amended this claim according to the Examiner's suggestion and as such, Applicant submit that the objection to Claim 22 has been rendered moot.

## **REJECTION UNDER 35 U.S.C. § 103**

Claims 22-26, 28, 29, 32, 33, 35, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heschung (FR 2 356 361 A) in view of Friesner et al. (WO 93/03603). This rejection is respectfully traversed.

Appellant respectfully submits that the Office has not presented a *prima facie* case of obviousness. The establishment of a *prima facie* case of obviousness requires that three basic criteria be met: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, 2) that there must be a reasonable expectation of success, and 3) that the prior art reference or references must teach or suggest all the claim limitations. See, e.g., *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438

(Fed. Cir. 1991). Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure. *Id.*

Regarding the suggestion or motivation to modify the Heschung device, Applicant notes that the Patent Laws draw a distinction between trade-offs and motivation to combine: trade-offs often concern what is feasible, not what is necessarily desirable, whereas motivation to combine requires the latter. See, e.g., *Winner International Royalty Corp. v. Wang*, 2002 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir.), *cert. denied*, 530 U.S. 1238 (2000).

In the instant case, the Examiner argues that as Heschung appears to disclose a shield having a linear lap joint, it would have been obvious to one of skill in the art to make the wall of Heschung shield from a resilient self-coiling material so as to have a convenient and easy closing means. Applicant notes, however, that the body of the Heschung shield is meant to be coupled to elements 4 and 6 at its opposite ends. More specifically, Applicant notes that the ends of the body of the Heschung shield must conform to precise dimensions so that the elements 4 and 6 can be properly coupled to the body. Accordingly, the incorporation of a resilient and self-coiling feature into the body of the Heschung shield would be undesirable as the body and the end elements (4 and 6) would not fit together as intended. Consequently, the modification proposed by the examiner is a trade-off rather than the requisite motivation to combine since it concerns what may be feasible rather than what is necessarily desirable.

Given the aforementioned issues in the sizing of the ends of the body relative to the end elements (4 and 6), Applicant also submits that there is no reasonable expectation of success.

In view of the above remarks, Applicant submits that the Examiner has not presented a prima facie case of obviousness and respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 22, 35 and 36 under 35 U.S.C. 103(a).

Applicant notes that Claims 23-26, 28, 29, 32 and 33 depend from Claim 22 and as such should be in condition for allowance for the reasons set forth above for Claim 22.

Claim 27 stands rejected as being unpatentable over Heschung in view of Friesner et al. and in further view of Posa (U.S. Pat. No. 6,115,960). This rejection is respectfully traversed. Applicant submits that the improper combination of Heschung and Friesner et al., as discussed above with respect to independent claims 22, 35, and 36, renders the instant objection moot. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the instant rejection.

Claims 30 and 31 stand rejected as being unpatentable over Heschung in view of Friesner et al. and in further view of Koffler et al. (U.S. Pat No. 4,829,707). This rejection is respectfully traversed. Applicant submits that the improper combination of Heschung and Friesner et al., as discussed above with respect to independent claims 22, 35, and 36, renders the instant objection moot. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the instant rejection.

#### **FINALITY OF ACTION**

Applicant notes that while Final Rejection after a first action on the merits is generally permitted when the Applicant has amended the claims in view of the art cited by the Office, the undersigned attorney submits that the finality of the Office's last action is

premature in that it deprives the Applicant of a full and fair opportunity to prosecute the application.

Applicant notes that the Office had previously rejected the claims pending in the present application on the basis of USPN 5,809,690 (folding plant guard with no resilient self-closing means), WO 03/096791 (folding plant guard with no resilient self-closing means) and RU 2 118 487 (bell-shaped shell employed as a plant guard) despite the fact that Applicant had claimed a "closure means" that permitted Applicant's mulch shield to resiliently close (e.g., coil) around the trunk of a tree. In discussing this aspect with Examiner Gellner on September 15, 2006, the Examiner noted that amending the claims to expressly describe the mulch shield as having a self-closing configuration and cleats did overcome the art of record and would likely overcome all other prior art, including seeding tubes and tubes for the protection of saplings (e.g., split convoluted tubing). Accordingly, Applicant presented new claims 22-36 in compliance with the remarks of the Examiner.

Despite the Examiner's remarks in the aforementioned interview, the Examiner rejected new claims 22-36 based on newly cited art (FR 2356361 and WO 93/03603) in the last Office Action and made the action final.

Applicant submits that because the Examiner induced the Applicant into making the aforementioned amendments only to thereafter reject the claims on new art and make this action final, the Office has deprived the Applicant of a full and fair opportunity to prosecute the application. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the finality of the action.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the

Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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